

REMARKS

The claims in the application are 21-27, 29-32, 34-39, 49-51 and Claims 52-59 added by the present amendment.

Favorable reconsideration of the application as amended is respectfully requested.

The present amendment is submitted in accordance with a telephone interview conducted between the Examiner in charge of the above-identified application and the undersigned attorney on Tuesday, October 11, 2005. The courtesy extended by the Examiner in arranging for and conducting the telephone interview, is greatly appreciated.

Claims 21, 31, 32, 35 and 51 have been amended as presented for discussion during the telephone interview, with Claims 21 and 31 additionally amended to recite the preparation may comprise hydrolyzed powder product of sericin with a purity of 90% or higher; support for this recitation is found, e.g., in paragraphs [0020] and [0025] on pages 5-6 of the application. Additionally, the "single protein extraction" recitation has been dropped from Claims 32, 35 and 51 while these three claims have also been amended to recite the hydrolyzed sericin product has a purity of 90% or higher. The molecular weight recitation deleted from claims 21 and 31 has been reintroduced as Claims 52 and 53 respectively, while support for Claims 54-59 can be found, e.g., in Tables 3 and 7 on pages 14-15 and 17-18 of the specification.

Concerning the rejections raised under 35 U.S.C. §112, second paragraph raised in the final Office Action, it is pointed out molecular weight is conventionally understood as being based upon atomic weight. Thus, for

example, methanol, CH₃OH is understood as possessing a molecular weight of 32, without units of measurement. In this regard, the particular molecular weight recitation has been presented in dependent Claims 49, 50, 52 and 53.

Recitation of the "single protein extraction" has been deleted from all claims, to eliminate confusion with the recitation "a purity of 90% or higher." It is also pointed out there is support for recitation of sericin/hydrolyzed product powder in paragraphs [0022] and [0023] on page 6 of the application Preparation Examples 1 and 2 in paragraphs [0035] and [0036] on page 9 of the application. Concerning the rejection raised under 35 U.S.C. §112, first paragraph, it is again respectfully submitted there is more than adequate support for the claimed molecular weight limitations throughout the present application.

Claims 32, 35 and 51 which have not been rejected over U.S. Pat. No. 6,165,982 to Yamada et al, have been amended into independent form. As pointed out during the telephone interview, Yamada et al belong to assignee of the present application. The offer to file a terminal disclaimer beyond the patent life of Yamada et al, is again respectfully reiterated, should the Examiner now feel filing such a terminal disclaimer would eliminate Yamada et al as a reference. In any event, it is respectfully submitted Yamada et al, at most, might render obvious but fail to anticipate the claimed invention, so Yamada et al cannot be applied as a reference under 35 U.S.C. §§102(e)/103 because Yamada et al belong to a common assignee (please see M.P.E.P. §706.02(k)).

More particularly, Yamada et al fail to even suggest colon cancer prevention, much less teach an effective amount of sericin/hydrolyzed product for preventing colon cancer. In this regard, it is respectfully reiterated the term "effective

amount” has long been recognized as defining over prior art (please see the case citations in the previous amendment) and does not constitute merely functional or intended use recitation. Furthermore, Yamada et al fail to teach presence of a mineral mix in combination with sericin (please see Claim 31).

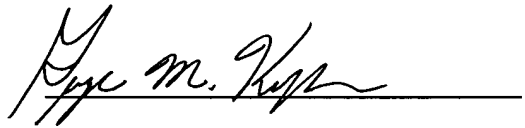
Moreover, Claims 54-59 introduced herein are directed to specific amounts of sericin/hydrolyzed product incorporated into the claimed preparation. It is acknowledged these claimed ranges fall within the broad ranges disclosed at column 4, lines 29-37 of Yamada et al. However, the specific examples in Yamada et al all show amounts of sericin below the claimed ranges. Furthermore, it is well-settled claimed proportions of ingredients can indeed impart patentability to a composition even where the percentages of ingredients fall within broader ranges in the prior art: Becket v. Coe (CADC 1938) 98 F.2d 332, 38 USPQ 26; In re Becket et al. (CCPA 1937) 88 F2d 684, 33 USPQ 33; In re Arness (CCPA 1938) 95 F2d 344, 37 USPQ 217; Ex parte Selby (POBA 1966) 153 USPQ 476; In re Waymouth et al. (CCPA 1974) 499 F2d 1273, 182 USPQ 290; and In re Russell (CCPA 1971) 439 F2d 1228, 169 USPQ 426. Attention is again respectfully called to the evidence present in the present application.

Accordingly, it is emphatically asserted Yamada et al fail to anticipate or render obvious the invention as recited in any claim. Even should the Examiner still feel Yamada et al renders the claimed invention obvious, nevertheless Yamada et al cannot then be applied as a reference for the reasons found in M.P.E.P. 706.02(k) *supra*.

Therefore, in view of the forgoing amendment, accompanying remarks and telephone interview in the above-identified application, it is respectfully submitted all claims pending herein are in condition for allowance. Please contact the undersigned attorney should there be any questions. The requisite transmittal papers for filing a Request for Continued Examination (RCE) are enclosed together with a petition for a one month extension of time for response under 37 C.F.R. §1.136(a) and requisite fees.

Early favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "George M. Kaplan", is written over a horizontal line.

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